

REMARKS/ARGUMENTS

A. Status of the Claims

Claims 26-48 and 57-81 are pending in the application, and claims 26, 28-45 and 78-81 are allowed. Claims 61-63 are objected to, and claims 27, 46-48, 57-60 and 64-77 are rejected, variously, under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §103. The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

B. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 27, 76 and 77 are rejected as indefinite in reciting "one or more depositions" without identifying which face of the lens is treated. Applicants have provided a clarifying amendment.

Claims 46, 47, 57-60, 64 and 65 are rejected as indefinite as providing "desired physical characteristics" lacking actual structure to achieve the same. A review of the claims reveals the recitation "imparts to the lens a surface energy" as possibly the subject of the examiner's concerns. However, surface energy is a well known parameter of a lens, and those of skill in the art (a specialist in optical thin layers) would know quite well how to achieve various surface energies. More importantly, this characteristic can be directly and positively verified by tests or procedures adequately specified in the description, without resorting to undue experimentation and without exercising inventive skill. These tests or procedures are also known to the person skilled in the art (see specification at page 4, lines 31-34), and involve the Owens-Wendt method, with reference to a classical article of 1969. This experimental technique for determining the surface energy features of layers is an objective procedure, which is typical in the art. Under no circumstance would this recitation be considered indefinite.

Turning to the terms “hydrophobic” and “oleophobic,” applicants further traverse the rejection. In the present situation, applicants should be allowed to recite the hydrophobic and/or oleophobic nature of layer as invention either can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claims. Thus, the definition of coatings as hydrophobic and/or oleophobic appears to be the most convenient in terms of concision of the claims, since it is not possible to list all the individual materials having the required surface energy in claim 46. It is worth noting, in this regard, that several examples of coatings encompassed by the claims are given in the specification

“Functional” claim limitations are not *per se* impermissible. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). Such limitations are particularly sanctioned where “used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.” See *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ 2d 1001, 1006-08 (Fed. Cir. 2004). With respect to indefiniteness, it was held that a limitation used to define a radical on a chemical compound as “incapable of forming a dye with said oxidizing developing agent” although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). The limitation in question here clearly does define the metes and bounds of what is claimed. See also MPEP 2175.03(g).

Claims 67-69 are rejected as indefinite for being “incomplete.” Applicants believe this to be a claim dependency issue, and an amendment is provided correcting the error.

Claims 66 and 72 are said to be indefinite for the use of the term “-based.” Applicants traverse, but in the interest of advancing the prosecution, an amendment is provided that is believed to address the examiner’s concerns.

Claims 73-75 are rejected as indefinite for being “incomplete.” Applicants believe this to be a claim dependency issue, and an amendment is provided correcting the error.

Reconsideration and withdrawal of each of the preceding rejections is respectfully requested.

C. Rejection Under 35 U.S.C. §103

Claims 46-48, 64, 65, 70 and 71 are rejected as obvious over U.S. Patent Publication 2003/0049370, published March 13, 2003. Applicants traverse.

In order for a reference to be applied in the context of §103, it must fall into one of the statutory definitions of prior art as provided in §102. A comparison of the inventive entity on the instant application with that of the ‘9370 application reveals *identity* – both Lacan and Conte are the sole inventors for both. As such, the reference is not “by another,” thereby eliminating §102(a), §102(e), §102(f) and §102(g). Clearly, §102(c) and §102(d) are inapplicable as well. Finally, as the ‘9370 application was published *after* the latest possible priority date of the instant application, that being January 13, 2003, the reference does not qualify under §102(b). Thus, there is no statutory basis for considering the ‘9370 application as prior art.

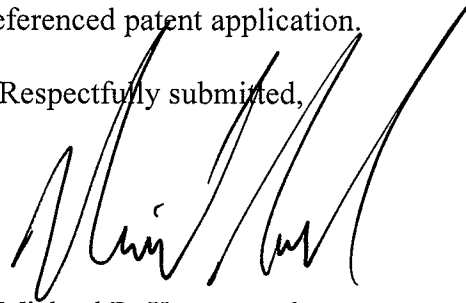
Reconsideration and withdrawal of the rejection is therefore requested.

D. Conclusion

This document is a full and complete response to the Office Action mailed December 5, 2008. The present case is in condition for allowance and such favorable action is requested.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael R. Krawzsenek', written over the text 'Respectfully submitted,'.

Michael R. Krawzsenek
Reg. No. 51,898
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
512.536.3020 (voice)
512.536.4598 (fax)

Date: March 5, 2009